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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/479,273      01/05/00      KRINSKY

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026389      MM91/0626  
CHRISTENSEN, O CONNOR, JOHNSON, KINDNESS  
1420 FIFTH AVENUE  
SUITE 2800  
SEATTLE WA 98101-2347

EXAMINER

YAN, R

ART UNIT

PAPER NUMBER

2854

DATE MAILED:

06/26/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/479,273

Applicant(s)  
Krinsky

Examiner  
Ren Yan

Art Unit  
2854



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 9, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 17-20 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Art Unit: 2854

Applicant's election without traverse of Group I, claims 1-9 in Paper No. 4 is acknowledged. Non-elected claims 10-16 have been canceled and new dependent claims 17-20 have been added.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 8, 9 and 17-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fredlund et al(5,815,645). The patent to Fredlund et al teaches the method of combining customer generated digital image with prestored basic digital image to form merged image and print such image on a substrate for decorative purpose as claimed including the use of a computer 10 equipped with a monitor and various input and output devices such as scanners, digital cameras, thermal and inkjet printers, etc. to create, combine and print desired merged digital images on substrates through the cooperation between the operator and the customer. See the entire Fredlund patent for details. With respect to claim

Art Unit: 2854

3, with the presence of the various printers 32-42 connected to the computer 10, to print the image displayed on the monitor on paper in order to view the actual printed image in terms of its color and sharpness qualities for the customer would have been obvious to one of ordinary skill in the art. With respect to claims 7-9, to print the merged images on a transfer medium to be later transferred onto a substrate by thermal printers or to print the merged images directly onto a substrate by an inkjet printer have been explicitly taught by Fredlund et al in column 3, lines 46-55. Regarding claims 17, 19 and 20, since various digital images being stored in the computer 10 of Fredlund et al and any one of these images can be selected and digitally merged with the customer generated digital images, to pick and choose any design among a plurality of available design choices would have been most obvious to one of ordinary skill in the art.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al as applied to claim 1 above, and further in view of Durg et al(6,212,304). Fredlund et al may not mention the use of E-mail as an input device to generate digital images. Durg et al disclose in column 1, lines 17-21 that it has become common practice to send digital images among computers via electronic mail. In view of the teaching of Durg et al, it would have been obvious to those having ordinary skill in the art to provide the computer 10 of Fredlund et al with the necessary Internet and electronic mail connections appropriately disposed as taught by Durg et al as an additional means to receive customer generated digital images.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al as applied to claim 1 above, and further in view of Jablonski(5,685,657). The patent to Fredlund et

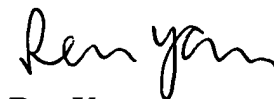
Art Unit: 2854

al may not teach to provide a protective coating on the printed image. Jablonski teaches in a printer the conventionality of providing a transparent protective coating on the printed color image. See column 4, lines 53-56 in Jablonski for example. It would have been obvious to those having ordinary skill in the art to provide the printed image in the Fredlund patent with a protective coating in order to achieve the inherent advantage of prolonging the useful life of the image.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren Yan whose telephone number is (703) 308-0978. The examiner can normally be reached on weekdays from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hilten, can be reached on (703) 308-0719. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-5841.



**Ren Yan**  
**Primary Examiner**  
**Art Unit 2854**

Ren Yan  
June 22, 2001